

REMARKS

Applicant has carefully reviewed the Office Action mailed March 15, 2004. In that office action, claims 32, 36-42 and 48 were rejected under 35 U.S.C. § 102(b) as being anticipated by Affidavits signed by Alexander Shek. Further, claim 43 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shek Affidavits in view of U.S. Patent No. 5,925,500 to Yang et al., claims 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shek Affidavits in view of U.S. Patent No. 5,116,533 to Grandmont et al., claims 46 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shek Affidavit to Herman Fuller in view of U.S. Patent No. 5,503,583 to Hippely et al., and claims 49-51 were rejected for the same reasons as the claims they are based upon.

In addition to the rejections described above, the Examiner argues on page two of the office action that “the applicant is not the original inventor.” Because the Examiner has not cited any statutory basis for this argument, Applicant has searched the patent statute to ascertain the meaning of “original inventor.” Section 115 of the patent statute requires that an applicant make an oath that he believes himself to be the original and first inventor. This is not a requirement that an applicant must actually be the original and first inventor to obtain a patent, but rather it is a way to make the applicant declare he did not derive the invention from another person or source. This fact is dictated by the common meaning of the term “original” and the language of the statute.

“Original inventor,” as used in 35 U.S.C. § 115, refers to an applicant that did not derive the invention from someone else. The term “original inventor” is not defined in the statutes or rules. The American Heritage College Dictionary defines “original” as “1. Preceding all others

in time; first. 2a. Not derived from something else...” 4th ed., 2002. From this definition, it can be seen that the relevant meaning given to “original” is either “first” or “not derived from something else.” However, as the term “original” is used in 35 U.S.C. § 115, it cannot mean “first.” This is because 35 U.S.C. § 115 requires the applicant to aver that he believes himself to be the original *and* first inventor. As a matter of statutory interpretation, “original” in 35 U.S.C. § 115 must mean something other than “first,” otherwise the statute would be redundant. Since “original” does not mean “first,” it must mean “not derived from something else.” Although the Examiner did not argue that an applicant must be a first inventor to be entitled to a patent, in the interest of completeness it is noted here that no such requirement exists.

With regard to the instant application, Applicant properly executed an oath stating that he believed himself to be the original inventor of the invention. The Shek Affidavits do not provide evidence of, or even allege, that Applicant derived the invention from another source. Shek merely states that he engaged in certain processes before the Applicant’s critical date, not that Applicant derived the process from Shek or from anyone else. Further, there is no evidence of derivation anywhere else in the record. Therefore, because there is no factual basis for concluding that Applicant derived the claimed invention from another, Applicant respectfully requests any objection based on Applicant’s alleged lack of original inventor status be withdrawn.

In the interest of completeness, it is noted that when the Examiner argued on page two of the office action that “the applicant is not the original inventor” the Examiner may have actually meant “the applicant is not the [first] inventor.” When considering whether such an objection

should prevent Applicant from obtaining a patent, an analogy may be drawn to the facts in Palmer v. Dudzik, 481 F.2d 1377 (CCPA 1973).

The Palmer case concerned a method and apparatus for producing textured yarn (this invention is described in U.S. Pat. No. 3,831,362 to Dudzik). Palmer was an employee of a company named Duplan. In the fall of 1965, Palmer equipped Duplan's machine Number 7 with ring devices in accordance with the invention. Id at 1378. Palmer equipped Duplan's "Turbo" machine with the invention in the fall of 1966. Id. Duplan management decided not to file a patent application on the invention. Id at 1378. Rather, Duplan sought to simply use the invention and try to keep it as unpublicized as possible. Id.

"Dudzik independently conceived of the invention on May 8, 1967, and reduced it to practice on May 9, 1967." Id at 1379. The BPAI found that "[u]nder the circumstances of this case, we believe that Dudzik, a subsequent inventor of the same subject matter of the counts in issue who diligently pursued his labors in attempting to procure a patent in good faith and without any knowledge of the preceding discoveries of another, Palmer, should as against the other, who has deliberately concealed the knowledge of his invention from the public, be regarded as the real inventor and as such entitled to his reward under the patent laws." Id at 1379. The U.S. Court of Customs and Patent Appeals affirmed the BPAI decision. Accordingly, U.S. Pat. No. 3,831,362 was granted to Dudzik in spite of the fact that Palmer had literally conceived of the invention and reduced it to practice before Dudzik.

Also in the office action mailed March 15, 2004, claims 32, 36-42 and 48 were rejected under 35 U.S.C. § 102(b) as being anticipated by Affidavits signed by Alexander Shek. Section 102(b) of the patent statute "bars public use or sale, not public knowledge." MPEP Sec.

2133.03(a). Therefore, “[m]ere knowledge of the invention by the public does not warrant rejection under 35 U.S.C. 102(b).” MPEP Sec. 2133.03(a) citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983).

In Gore, a party named Budd used a machine manufactured by a party named Cropper to produce and sell PTFE thread seal tape. Id. at 1549. Garlock (the accused infringer) argued that Budd’s activities invalidated U.S. Pat. No. 3,953,566 to Gore. Id. The court observed that even assuming “that Budd sold tape produced on the Cropper machine ... and that that tape was made by the process set forth in a claim of the ‘566 patent, the issue under 102(b) is whether that sale would defeat Dr. Gore’s right to a patent on the process inventions set forth in the claims.” Id. at 1550. “If Budd offered and sold anything, it was only tape, not whatever process was used in producing it.” Id. Accordingly, “[t]here is no reason or statutory basis ... on which Budd’s and Cropper’s secret commercialization of a process, if established, could be held a bar to the grant of a patent to Gore on that process.” Id.

In the office action mailed 11/28/2003 the Examiner argues that the present situation can be distinguished from Gore, stating that “[t]he Shek affidavits do not claim that Shek or the company represented by Shek to be the original inventor(s) of this lithophane article or method of making.” Applicant has carefully reviewed the Shek affidavits and notes that these affidavits do not indicate whether or not Shek considers himself to be an original inventor of the methods describe therein. Accordingly, the record does not provide a factual basis for concluding that the two situations are different in the way identified by the Examiner. Even if it were assumed, arguendo, that this is a difference between the two situations; Applicant respectfully submits that this difference is not material to the instant rejection.

In the present case, the Shek affidavits do not allege the public use of a method used to produce lithophanes. “As between a prior inventor who benefits from a process by selling its product but suppresses, conceals, or otherwise keeps the process from the public, and a later inventor who promptly files a patent application from which the public will gain a disclosure of the process, the law favors the latter.” W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983). For this reason, Applicant respectfully submits that claims 32, 36-42 and 48 are in condition for allowance. Further, since the activities described in the Shek affidavits do not qualify as prior art, the Examiner has not shown all of the elements of the claimed invention in the prior art as required by 103(a), and has therefore not made out a prima facie case of obviousness. Hence, claims 43-47, and 49-51 are also in condition for allowance.

Application No. 09/884,237

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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